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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,308	09/18/2006	Yvonne Heischkel	295788US0PCT	7530

22850 7590 03/23/2009  
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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BALASUBRAMANIAN, VENKATARAMAN

ART UNIT	PAPER NUMBER
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1624

NOTIFICATION DATE	DELIVERY MODE
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03/23/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/593,308	<b>Applicant(s)</b> HEISCHKEL ET AL.	
	<b>Examiner</b> /Venkataraman Balasubramanian/	<b>Art Unit</b> 1624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Applicants' response which included cancellation of claims 1-10 and addition of new claims 11-20, filed on 12/19/2008, is made of record. In view of applicants' response, all rejections made in the previous office action have been rendered moot.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claim 11 and its dependent claims 12-20 are indefinite as "recitation of optionally, with an alcohol of the formula  $R^2-OH$ , an amine of the formula  $R^2-NH_2$ , an alcohol of the formula  $R^1-OH$  and/or an amine of the formula  $R^1-NH_2$ " renders claim 11 vague and unclear as to its structural make-up. Note when  $Y^1$  is  $CO-OR^4$  and or  $Y^2$  is  $CO-OR^5$ , if the reaction with an alcohol of the formula  $R^2-OH$ , an amine of the formula  $R^2-NH_2$ , an alcohol of the formula  $R^1-OH$  and/or an amine of the formula  $R^1-NH_2$  will not lead to formula I as  $Y^1$  and  $Y^2$  are same as  $Z^1$  and  $Z^2$ .
2. Recitation of "if appropriate" in claim 13 at various places renders claim 13 indefinite as it is not clear when it is appropriate to interrupt the alkyl chain.
3. Recitation of "compounds" in various places in dependent claim 17 renders the claim vague and unclear. Note claim 11 relates to a process of making a compound of

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formula I not a mixture of compounds. In addition recitation of "precisely one hydroxyl" is vague. Deletion of "precisely" is suggested. See claim 18 for the same.

4. Regarding claim 17, the phrase "preferably" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

5. Claim 17 is also indefinite as it depends on cancelled claim 5 for X definition.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Wu et al., WO 01/40368.

Wu teaches use of 1,3,5-triazine carbamate in coating composition for coating various substrates, which include instant method of coating with 1,3,5-triazine carbamate. See pages 3-9 for various 1,3,5-triazine carbamate and coating compositions containing them. See pages 9-17 for details of such compositions. See pages 18-23 for the use of coating compositions. See pages 24-48 for examples 1-12.

Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Schultz et al., WO 98/18856.

Schultz teaches use of 1,3,5-triazine carbamate in coating composition for coating various substrates, which include instant method of coating with 1,3,5-triazine

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carbamate. See pages 3-10 for various 1,3,5-triazine carbamate and coating compositions containing them. See pages 11-17 for details of preparation of such compositions and method of coating. See page 18, lines 1-10 for the use of coating compositions. See pages 18-26 for examples 1-6.

Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Gupta et al., US 5,852,133.

Gupta teaches use of 1,3,5-triazine carbamate in coating composition for coating various substrates, which include instant method of coating with 1,3,5-triazine carbamate. See column 1-11 for various 1,3,5-triazine carbamate and coating compositions containing them. See column 11-13 for details of preparation of such compositions and method of coating. See column 13, lines 17-28 for the use of coating compositions. See for examples 1-5.

Instant claim 20 is drawn to a method of use based on product by process. A product is a product irrespective of how it is made. The processes attributes are independent limitation and do not necessarily define the structural make-up of the product. The claim 20 is not rendered patentably distinct by a process directed to its preparation even though the process may be patentable. Note "Determination of patentability in "product by process" claims is based on product itself, even though such claims are limited and defined by process, and thus product in such claim is unpatentable if it is same as, or obvious from, product of prior art, even if prior product was made by different process" In re Thorpe 227 USPQ 964. Also note In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972), the court held that "The lack of

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physical description in a product by process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established.”

### ***Conclusion***

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

/Venkataraman Balasubramanian/

Primary Examiner, Art Unit 1624

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